

Attorney Docket No. SIC-00-001-4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

KENJI OSE

Application No.: 09/992,597

Filed: November 14, 2001

For: SWITCH STYLE BICYCLE SHIFT  
CONTROL DEVICE

Examiner: Chong Hwa Kim

Art Unit: 3682

RESPONSE TO REMAND UNDER  
37 C.F.R. §41.50(a)(1) AND  
ORDER UNDER 37 CFR §41.50(d)

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Commissioner:

This is a response to the order dated October 29, 2007.

Appellant has been ordered to provide a copy of Figure 13 which labels the “radially innermost outer peripheral surface of the dial.” A copy of Figure 13 is attached as Exhibit D. Initially, it should be noted that reference number (570) does not refer to a surface “that is orthogonal to surface (512)” as stated at page 2, lines 11-13 of the Order. Reference number (570) refers to the dial portion of the device as stated at page 14, line 1 of Appellant’s specification. The “radially innermost outer peripheral surface of the dial” refers to the surface that defines the radially outer boundary of dial portion (570). Appellant previously used Figures 14 and 15 because those Figures show the complete outer boundary of dial portion (570), whereas projection (584) blocks the complete view of dial portion (570) in Figure 13. Appellant did not intend to imply that the outer peripheral surface includes a portion of the upper surface of dial portion (570).

As for the requirement that the finger contact projection (584) “protrudes radially inwardly from a radially innermost outer peripheral surface of the dial,” it is not true that the Appellant

alleged that the quoted feature requires that the finger contact projection “extends from the rotatable dial in a direction of the rotational axis.” The requirement that the finger contact projection “extends from the rotatable dial in a direction of the rotational axis” is separately recited at lines 11-12 of claim 34. The Appellant was explaining how the requirement that the finger contact projection (584) “protrudes radially inwardly from a radially innermost outer peripheral surface of the dial” is required in *addition* to the requirement in lines 11-12 of claim 34 that the finger contact projection “extends from the rotatable dial in a direction of the rotational axis,” and how this additional requirement is that the finger contact “also extends radially away from the outer peripheral surface and has at least a portion that is located a distance from the rotational axis that is less than the length of the radius (R) from the rotational axis.”

The Appellant now recognizes the ambiguity in the word “away” standing alone, since the dictionary definition of “away” is “from this or that place.” Thus, Appellant’s statement could mean either “inwardly away” or “outwardly away.” The Appellant was attempting to paraphrase the “protrudes radially inwardly...” language to make it easier to understand and, unfortunately, did just the opposite. The sentence bridging pages 2 and 3 of the Order is substantially correct. The outer peripheral surface is the portion of the surface pointed to by lead line (512) that defines the outer boundary of dial portion (570) (best seen in Figs. 14 and 15), and element (584) extends radially inwardly from that outer boundary, not radially outwardly away from that surface, and that is the proper interpretation and application of the claim language.

The order also requested clarification of the statement that at least a portion of the finger contact projection (584) “is located a distance from the rotational axis that is less than the length of the radius (R) (labeled in the exhibits) that extends from the rotational axis to the radially innermost outer peripheral surface(s).” First, contrary to the statement at page 3, lines 7-10 of the Order, it is not a requirement of the claim that the finger contact projection extends across the entirety of the surface. The quoted statement was intended provide a specific mathematical formulation that means simply that some portion of the finger contact projection is located less than the radius. Such a portion is intended to allow the device to be “operated by grasping the finger contact projection with the two fingers or the finger and the thumb *radially inwardly* from the radially innermost outer peripheral surface” as recited in claim 34, lines 20-22.

KENJI OSE

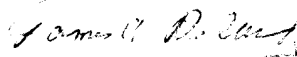
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As for the potential rejection of the phrase "radially innermost" as not being described in the specification as originally filed, it is believed that Figs. 13-15 provide support for the claim language, since the finger contact projection (584) protrudes radially inwardly from a radially innermost outer peripheral surface of the dial as shown by the bold outline in previously submitted Exhibit A and as shown by the shaded surface in Exhibit D.

Respectfully submitted,



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